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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, IL 60690-1135

EXAMINER

WILLIAMS, KENNETH C

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| ART UNIT | PAPER NUMBER |
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3739

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/649,199 | Applicant(s) NESBITT, BRUCE | |
| | Examiner Kenneth C. Williams | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 17, 18, 28 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 9-16, 19-27, 29-38 and 40-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 17, 18, 28 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the Amendment filed on January 30, 2006, amended claims 1, 18, 28 and 39, amendments to the specification and amendments to the drawings are acknowledged.
2. Claims 1-8, 17, 18 and 28 are *newly* rejected under 35 U.S.C. 103(a) as being unpatentable over Greep (U.S. Patent Application No. 20030163125) in view of Edwards et al. (U.S. Patent No. 5413788). Claim 39 is *newly* rejected under 35 U.S.C. 103(a) as being unpatentable over Greep in view of Edwards et al., further in view of Greep et al. (U.S. Patent Application No. 20030109864).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-8, 17, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greep (U.S. Patent Application No. 20030163125) in view of Edwards et al. (U.S. Patent No. 5413788).

In regards to Claims 1-8, 17, 18 and 28 Greep discloses an electrosurgical device comprising "an electrode" (See Figure 1, element 130), "a handle" (See Figure 1, element 120), "an electrical source" (See Figure 1, element 110), "a conductive substrate" (See Page 3, Paragraph 0035, line 6-14), "at least one substantially uniform coating applied to said substrate, wherein the coating includes a base material and a plurality of antimicrobial particles interspersed in said base material" (See Page 3, Paragraphs 0041 and 0042), "the conductive substrate includes a metal" and "the metal includes stainless steel" (See Page 3, Paragraph 0043, lines 6-11), "at least a portion of the conductive substrate includes an electrically insulative material includes the substantially uniform coating" (See Page 3, Paragraph 0035, lines 14-16), "a portion of the conductive substrate underneath the insulative material includes the substantially uniform coating" (See Page 3, Paragraph 0035), "the base material includes a non-stick material" (See Page 3, Paragraph 0041 and Page 4, Paragraph 0048), "the non-stick material includes at least one of the non-stick materials selected from the group consisting of: silicone, polytetrafluoroethylene, a fluoropolymer, ceramics and a combination of fluorosilicones" (See Page 4, Paragraph 0048), and "the anti-microbial particles includes at least one of the group consisting of: silver particles and ceramic" (See Page 3, Paragraphs 0041 and 0042).

Greep does not disclose “anti-microbial particles are formulated to reduce or kill a plurality of microbial organisms independent of any energy source”. Attention is directed to the Edwards et al. reference, which provides a pertinent solution to the problem of providing an anti-microbial coating on medical devices; discloses an anti-microbial composition used to provide a sustainable anti-microbial effect without any energy source (See Edwards et al. column 1, line 25 – column 2, line 59). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the coating of Greep with the coating of Edwards et al. to provide a sustainable anti-microbial coating without the aid of an energy source.

6. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greep in view of Edwards et al. as applied to claims 1-8, 17 and 18 above, and further in view of Greep et al. (U.S. Patent Application No. 20030109864).

In regards to Claim 39, Greep in view of Edwards et al. discloses a method of coating an electrosurgical device comprising “evenly applying a substantially uniform coating to a surface of the conductive substrate, said coating including a base material and a plurality of anti-microbial particles interspersed in the base material” (See Greep Page 3, Paragraphs 0036, 0041 and 0042) and “said anti-microbial particles are formulated to reduce or kill a plurality of microbial organisms independent of any energy source” (See Edwards et al. column 1, line 25- column 2, line 59).

Greep in view of Edwards et al. does not disclose “at least partially curing the substantially uniform coating”. Attention is directed to the Greep et al. reference, which in an analogous field of endeavor discloses a method of partially curing a base material

and filler on a substrate (See Greep et al. Page 2, Paragraph 0031). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the partial curing method of Greep et al. to the method of Greep in view of Edwards et al. to allow particles to be permanently embedded in the base material.

Response to Arguments

7. Drawing objections and objections to the specification are withdrawn due to submission of an amendment filed on January 30, 2006.

8. 35 U.S.C. 112 rejection of claim 18 is withdrawn due to submission of an amendment filed on January 30, 2006.

9. Applicant's arguments, see Page 26-27, filed January 30, 2006, with respect to the rejection(s) of claim(s) 1-8, 17, 18 and 28 under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of a newly found prior art reference. Applicant argues Greep does not disclose "catalytic particles that are formulated to break such bonds independent of any energy source" (See Applicant's Remarks Page 26, lines 20-22). The addition of the Edwards et al. reference to the Greep reference teaches a sustainable anti-microbial effect without any energy source.

10. Applicant's arguments, see Page 27-28, filed January 30, 2006, with respect to the rejection(s) of claim(s) 39 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of a newly found prior art

reference. Applicant argues Greep in view of Greep et al. does not disclose "catalytic particles that are formulated to break bonds that have occurred between the eschar and the surface of the electrode independent of any energy source" (See Applicant's Remarks Page 27, lines 17-18). The combination of Greep in view of Edwards et al. further in view of Greep et al. teaches a method of providing a sustainable anti-microbial effect without any energy source.

Conclusion

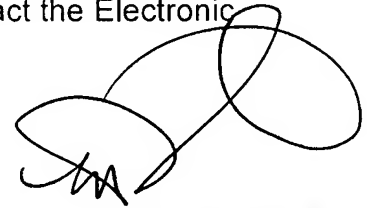
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth C. Williams whose telephone number is (571) 272-8161. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
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KCW
3/6/2006